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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,047	08/18/2003	Dennis K. Fisher	ADO 0101 PA	3107

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EXAMINER
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LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/643,047	<b>Applicant(s)</b> FISHER, DENNIS K.	
	<b>Examiner</b> Rip A. Lee	<b>Art Unit</b> 1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 11 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action follows a response filed on June 29, 2006. Claims 1-3 were amended, claim 14 was canceled, and new claims 26 and 27 were added.

#### ***Election/Restrictions***

1. Applicant's election with traverse of group I, claims 1-13, 26, and 27 is acknowledged. The traversal is on the ground(s) that there is no additional burden to search non-elected claims. This is not found persuasive because inventions of groups I and II have been shown to be independent and distinct (see previous office action).

The requirement is still deemed proper and is therefore made FINAL.

#### ***Claim Objections***

2. Claim 11 is objected to because of the following informalities: Claim 11 appears to depend from claim 10 rather than from claim 8. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 8-10, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gothjaelsen *et al.* (U.S. 6,509,391) alone, or in view of Ardegmani (U.S. 4,072,735).

Example 2 of Gothjaelsen *et al.* discloses an adhesive composition comprising equal amounts of Kraton G1726 SEBS block copolymer, Vistanex LM-MH (polyisobutylene), and Hyvis 10 polybutene (amorphous polyolefin); col. 7, lines 14-19. The table shows that equal amounts are not used (5 % SEBS and 15 % PIB), however, in light of the other data and in the fact that up to 20 wt % of block copolymer is used (claim 1), one having ordinary skill in the art would have found it obvious to use equal amounts as 15 % SEBS and 15 % PIB as the base resin

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for adhesive formulations. The inventors contemplate use of solid hydrocarbon resin tackifier (claim 3, col. 4, lines 49-57), and although the examples do not show such an embodiment, it would have been obvious to one having ordinary skill in the art to use hydrocarbon resins in order to modify the adhesive properties of the composition because this is explicitly taught in the reference. As such, it would have been obvious to one having ordinary skill in the art to arrive at the unexceptional base composition of instant claims 1-4. One having ordinary skill in the art also would have found it obvious to arrive at the subject matter of claims 8-10 from the teachings of the prior art: inventive compositions may further comprise plasticizer (col. 4, lines 44-48) and filler (col. 5, lines 16-18). Compositions may be in the form of a rod with a release liner (col. 7, line 3). The reference does not state that the form of the composition is a tape, however, it is maintained that one of skill in the art would have found it obvious simply to vary the form to suit the end use, especially where no dimension is indicated in the claims to distinguish a thin rod from a tape.

Even if the skilled artisan were woefully uninformed of the various forms of adhesive, he need only turn to Ardegmani. Ardegmani shows similar hot melt adhesive compositions having various end uses, one of which being an adhesive strip protected by a release liner. When the adhesive is needed, the release liner is removed and two surfaces may be adhered by the adhesive (col. 3, lines 42-52). One of ordinary skill in the art, having both references at hand, would have found it obvious to use the rod-shaped adhesive/release liner configuration of Gothjaelpsen *et al.* and make a tape-shaped adhesive/liner assembly as described in Ardegmani.

The reference is silent with respect to the properties described in instant claims 26 and 27, however, in view of the fact that the composition of the prior art is essentially the same as that recited in the claims, a reasonable basis exists to believe that the composition of the prior art exhibits essentially the same properties. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

5. Claims 1-12, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (U.S. 6,482,281) in view of Ardegmani (U.S. 4,072,735).

Schmidt discloses a hot melt adhesive comprising up to 15 wt % of thermoplastic elastomer, 15-55 wt % of polyisobutylene, 5-40 wt % of poly- $\alpha$ -olefin, 5-45 wt % of tackfier, filler, and stabilizers (claim 1). Amorphous polypropylene homopolymer as well as amorphous poly(propylene/1-butene) copolymer may be used as the amorphous polyolefin component for inventive adhesive compositions (see examples 1 and 2). Silica is a useful filler (col. 7, line 40). Schmidt further instructs that rheological properties of the adhesive may be optimized by use of butyl rubber (col. 7, lines 21-29). Schmidt also discloses use of sterically hindered phenols (antioxidant) and phosphites (flame retardant) in the adhesive formulation (col. 7, lines 42-44). It can be seen that one having ordinary skill in the art to arrive at the unexceptional base composition of instant claims 1-5 and further additives recited in claims 6-12.

The reference does not teach the shape or form of the composition as recited in the instant claims. That is, Schmidt does not teach the intended use of the composition being flat and having a release liner. Ardegmani shows that similar hot melt adhesive compositions have various end uses, one of which is an adhesive strip is protected by a release liner. When the adhesive is needed, the release liner is removed and two surfaces may be adhered by the adhesive (col. 3, lines 42-52). One of ordinary skill in the art would have found it obvious that the compositions of Schmidt are capable of performing this intended use, and accordingly, one having ordinary skill in the art would have expected such an embodiment to work with a reasonable expectation of success. As such, one of ordinary skill in the art, having both references at hand, would have found it obvious to use the adhesive of Schmidt with a release liner as shown in Ardegmani in order to protect the adhesive until its use is required.

The reference is silent with respect to the properties described in instant claims 26 and 27, however, in view of the fact that the composition of the prior art is essentially the same as that recited in the claims, a reasonable basis exists to believe that the composition of the prior art exhibits essentially the same properties. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252,

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1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

6. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Response to Arguments*

7. The rejection of claims under 35 U.S.C 102(e) as being anticipated by Schmidt has been withdrawn. Applicant's arguments with respect to this and subsequent obviousness type rejections under 35 U.S.C.103(a) have been considered but are moot in view of the new grounds of rejection.

### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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September 15, 2006

  
LING-SUI CHOI  
PRIMARY EXAMINER